

Appl. No. 10/020,637
Amdt. dated July 6, 2006
Reply to Office Action of March 14, 2006

REMARKS

Claims 1-30 are presented for Examiner Meinecke Diaz's consideration. In the Office Action mailed March 14, 2006, the Examiner rejects claims 1-30. Claims 1, 2, 4, 6, 7, 9-11, 13-15, 19, 26, 27, 29 and 30 are amended herein; the amendments do not introduce any new subject matter and are fully supported by the Specification as filed for the application. Claims 17 and 18 are canceled. Based on the amendments and remarks made herein, Applicants respectfully request that the rejections be withdrawn and that the application be passed to allowance.

1. Paragraph 2 of the Office Action Mailed March 14, 2006: Objection to the Specification.

In the Office Action mailed March 14, 2006, the Examiner objects to the Specification because it contains an embedded hyperlink or other form of browser-executable code at Page 1, line 24. The Specification has been amended herein to remove the "embedded hyperlink" and therefore, the Applicants respectfully request that the objection be withdrawn.

2. Paragraph 4 of the Office Action Mailed March 14, 2006: Rejection of Claims 1-30 Under 35 U.S.C. §101.

In the Office Action mailed March 14, 2006, the Examiner rejects claims 1-30 under 35 U.S.C. §101 as lacking a useful, concrete and tangible result. The Examiner believes that claims 1-30 revolve around the steps of calculating a base preference for a product, calculating a downside for the product and calculating an upside for the product. The Examiner believes that the claimed invention does not incorporate a useful or tangible result. Applicants respectfully submit the following response to this rejection.

Independent claim 1 is amended herein to include a step of "comparing the base preference, the downside and the upside to identify product attributes affecting preference results". Support for this amendment to claim 1 is provided in the Specification as filed, for example at page 10, lines 6-12. No new matter is introduced by this amendment. Applicants respectfully submit that this amendment introduces the useful and tangible result of being able to "identify product attributes affecting preference results" to the method of claim 1.

Applicants respectfully traverse the rejection with respect to independent claim 8. Independent claim 8 is directed to a method for developing a product having first and second attributes including the steps of calculating a base preference, a downside, and an upside for the first attribute; calculating a base preference, a downside, and an upside for the second attribute; comparing the calculations to

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determine which attribute is superior; and developing the product with the superior attribute. The useful and tangible result of the method of claim 8 is "developing the product with the superior attribute". The Examiner does not provide a specific analysis of independent claim 8 in the Office Action and therefore, does not address the utility of the claim element, "developing the product with the superior attribute".

Independent claim 15 is amended herein to include a step of "comparing the base preference, the downside and the upside to identify product attributes affecting preference results". Support for this amendment to claim 15 is provided in the Specification as filed, for example at page 10, lines 6-12. No new matter is introduced by this amendment. Applicants respectfully submit that this amendment introduces the useful and tangible result of being able to "identify product attributes affecting preference results" to the method of claim 15.

Independent claim 19 is amended herein to include a step of "comparing the base preference, the downside and the upside to identify product attributes affecting preference results". Support for this amendment to claim 19 is provided in the Specification as filed, for example at page 10, lines 6-12. No new matter is introduced by this amendment. Applicants respectfully submit that this amendment introduces the useful and tangible result of being able to "identify product attributes affecting preference results" to the method of claim 19.

Applicants respectfully traverse the rejection with respect to independent claim 20. Independent claim 20 is directed to a test results interpretation system including a computer, a computer code resident on the computer and a means for incorporating nonpreferential results into the product preference calculation. Claim 20 is not directed to a method including calculating steps and therefore, it is not clear from the Office Action how the Examiner is questioning the utility of this claim. The Examiner does not provide an analysis for claim 20.

Applicants respectfully traverse the rejection with respect to independent claim 21. Independent claim 21 is directed to a test results interpretation system including a matrix of responses and a computer code resident on a computer. Claim 21 is not directed to a method including calculating steps and therefore, it is not clear from the Office Action how the Examiner is questioning the utility of this claim. The Examiner does not provide an analysis for claim 21.

For at least these reasons, Applicants respectfully request that the rejection of claims 1-30 under 35 U.S.C. §101 be withdrawn.

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3. Paragraph 6 of the Office Action Mailed March 14, 2006: Rejection of Claims 1-30 Under 35 U.S.C. §112, second paragraph.

In the Office Action mailed March 14, 2006, the Examiner rejects claims 1-30 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the Examiner's rejection for the reasons stated below.

With respect to claim 1, the Examiner believes claim 1 recites that a base preference, a downside and an upside for a product are calculated and that these values are based on a test subject's subjective opinion and therefore, cannot be derived from a calculation. The Examiner further believes that without any clarification of the intended scope of the base preference, downside and upside of a product, the metes and bounds of each respective aspect of the product are unclear. Applicants respectfully submit that the Examiner is in error with respect to her belief that the base preference, downside and upside are based on subjective opinion and cannot be derived from a calculation. Applicants direct the Examiner's attention to pages 7 and 8 of the Specification as filed where a description is provided of how the base preference, downside and upside are calculated from available data. Therefore, claim 1 as amended herein, is definite and particularly points out and distinctly claims the subject matter which Applicants regard as the invention.

With respect to claim 2, the Examiner believes that the phrase "no test subject prefers the product on its delivery of the attribute" is ambiguous. The Examiner also believes that use of the word "delivery" is unclear. Applicants respectfully submit that the Examiner is in error with respect to her belief that the language of claim 2 is ambiguous. Applicants direct the Examiner's attention to page 6 through page 10, line 5 of the Specification as filed for examples of what "delivery" of an attribute means and what "no test subject prefers the product on its delivery of the attribute" means. Because several examples are provided in the Specification to illustrate the meaning of claim 2, claim 2 is definite and particularly points out and distinctly claims the subject matter which Applicants regard as the invention.

With respect to claim 3, the Examiner believes it is not clear whether the ratio recited in claim 3 is part of an actual mathematical formula or just a comparison of two values. The Examiner seems to be questioning whether the ratio of claim 3 produces a "useful result". Applicants respectfully submit that the Examiner's comments in this regard are more appropriate with respect to the rejection made under 35 U.S.C. §101, previously discussed herein. Nevertheless, Applicants direct the Examiner's attention to page 7, lines 10-29 of the Specification as filed in which an example of how this ratio is calculated is provided. The useful result produced by calculation of the ratio described in claim 3 is the calculation of

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the "base preference". Therefore, claim 3 is definite and particularly points out and distinctly claims the subject matter which Applicants regard as the invention.

With respect to claim 4, the Examiner identifies that claim 4 recites that "the downside is the incremental overall preference above the base preference attributable to the attribute". The Examiner believes that a downside implies a negative attitude and therefore, the Examiner does not understand why a downside would be a preference above the base preference attributable to an attribute. Despite these remarks, the Examiner does not explain why she believes claim 4 is indefinite and fails to particularly point out and distinctly claim the subject matter that the Applicants regard as the invention. Nevertheless, even though the Examiner has not formulated a proper rejection, Applicants direct the Examiner's attention to page 7, line 30 to page 8, line 10 of the Specification as filed for an explanation of how "downside" is calculated. For at least these reasons, claim 4 is definite and particularly points out and distinctly claims the subject matter which Applicants regard as the invention.

With respect to claim 5, the Examiner believes that claim 5 recites that the downside for the product is calculated by taking the difference between the base preference and an overall preference. The Examiner also reiterates her belief that claim 1 does not clearly define the scope of a base preference, a downside and an upside for a product and therefore, it is not clear how the difference between the base preference and the overall preference yields a downside for a product. Further, the Examiner expresses her belief that if the subject matters of claims 2 and 5 were combined, there would be no comparison between "two equivalent versions of the same preference". The Examiner does not correctly recite the subject matter of claim 5; claim 5 is directed to the method of claim 1 wherein calculating the downside for the product includes taking the difference between a base preference and an overall preference, wherein the overall preference is the ratio of the number of test subjects who preferred the product overall to the total number of test subjects. Applicants remarks with respect to the Examiner's rejection of claim 1 under 35 U.S.C. §112, second paragraph are already provided herein. Applicants are unclear as to why the Examiner is combining the subject matters of claims 2 and 5. Claims 2 and 5 are two, separate dependent claims and their subject matters cannot be combined to form the basis of a rejection under 35 U.S.C. §112, second paragraph. Nevertheless, even though the Examiner has not formulated a proper rejection, Applicants direct the Examiner's attention to page 8, lines 1-10 of the Specification as filed for exemplary support for dependent claim 5. For at least these reasons, claim 5 is definite and particularly points out and distinctly claims the subject matter which Applicants regard as the invention.

With respect to claim 6, the Examiner believes that claim 6 recites that "the upside is the incremental overall preference attributable to the maximum potential attribute preference." The Examiner asks what an "incremental overall preference" is. Applicants have amended claim 6 herein

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and have removed the word, "incremental". For at least this reason, claim 6 as amended herein is definite and particularly points out and distinctly claims the subject matter which Applicants regard as the invention.

With respect to claim 7, the Examiner believes that there is no antecedent basis for "the overall preference" and "the best preference" in line 2 of claim 7. Applicants have amended claim 7 herein and Applicants appreciate the Examiner bringing the lack of antecedent basis for those terms to the Applicants' attention. Further with respect to claim 7, the Examiner questions whether the ratio described in claim 7 is a "meaningful value" and whether the upside has a "meaningful value". Despite these remarks, the Examiner does not explain why she believes claim 7 is indefinite and fails to particularly point out and distinctly claim the subject matter that the Applicants regard as the invention. Nevertheless, even though the Examiner has not formulated a proper rejection, Applicants direct the Examiner's attention to page 8, lines 11-27 of the Specification as filed for an explanation of how the "best preference" and the "upside" are calculated and constitute "meaningful values". For at least these reasons, claim 7 is definite and particularly points out and distinctly claims the subject matter which Applicants regard as the invention.

With respect to claims 8-30, the Examiner believes that these claims recite similar limitations as those recited in claims 1-7 and therefore, the same grounds for rejection apply. In response, Applicants respectfully submit that the remarks provided herein in response to the Examiner's rejection of claims 1-7 therefore apply to those of claims 8-30 containing similar terms. For the reasons provided herein, Applicants respectfully request that the rejection of claims 1-30 under 35 U.S.C. §112, second paragraph be withdrawn.

4. Paragraph 8 of the Office Action Mailed March 14, 2006: Rejection of Claims 1-19 Under 35 U.S.C. §102(b).

In the Office Action mailed March 14, 2006, the Examiner rejects claims 1-19 under 35 U.S.C. §102(b) as being anticipated by International Publication Number WO 98/18352 to Bauer et al. (hereinafter "the Bauer publication"). Applicants respectfully traverse the rejection.

With respect to independent claim 1, the Examiner believes the Bauer publication discloses a method for determining preference results for a product having an attribute where the method comprises calculating a base preference for the product; calculating a downside from the product and calculating an upside for the product. With respect to dependent claim 2, the Examiner believes the Bauer publication discloses the base preference is the overall preference for the product where no test subject prefers the product on its delivery of the attribute. With respect to dependent claim 3, the

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Examiner believes the Bauer publication discloses the base preference is the ratio of the number of test subjects who preferred the product overall but not with respect to the attribute to the number of test subjects who did not prefer the product with respect to the attribute. With respect to dependent claim 4, the Examiner believes the Bauer publication discloses the downside is the incremental overall preference about the base preference attributable to the attribute. With respect to dependent claim 5, the Examiner believes the Bauer publication discloses calculating the downside for the product includes taking the difference between a base preference and an overall preference, wherein the overall preference is the ratio of the number of test subjects who preferred the product overall to the total number of test subjects. With respect to dependent claim 6, the Examiner believes the Bauer publication discloses the upside is the incremental overall preference attributable to the maximum potential attribute preference. With respect to dependent claim 7, the Examiner believes the Bauer publication discloses calculating an upside for the product including taking the difference between the overall preference and the best preference, where the best preference is the ratio of the number of test subjects who preferred the product both overall and with respect to the attribute to the number of test subjects who preferred the product with respect to the attribute. The Examiner believes claims 8-19 recite limitations already addressed by the rejection of claims 1-7. For each of the claims, the Examiner refers to the subject matter on page 15 of the Bauer publication.

As already discussed, claim 1 as amended herein is directed to a method for determining preference results for a product having an attribute where the method includes calculating a base preference for the product; calculating a downside for the product; calculating an upside for the product; and comparing the base preference, the downside and the upside to identify product attributes affecting preference results.

In order to anticipate, a reference must teach each and every element of the claimed invention. The Bauer publication does not disclose calculating a base preference for the product, calculating a downside for the product or calculating an upside for the product. Page 15 of the Bauer publication reads "In the test summarized below, identical cleaning compositions were placed in similar spray articles, one with a foaming spray nozzle and the other with a non-foaming spray nozzle. Consumers were then asked to use the product to clean food surfaces, including apples. The results are summarized below:". At the top of the table, one of the column headings reads "Test Design: Paired Comparison". Page 15 of the Bauer publication does not describe calculating a base preference for the product, calculating downside or calculating an upside as contemplated by the present invention. In fact, the method of the present invention may rely on data collected through a paired comparison test (see Page 6 of the Specification as filed), but it is not the paired comparison test itself. For at least these reasons, independent claim 1 is patentable over the Bauer publication. Claims 2-7 are

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patentable over the Bauer publication at least for depending from independent claim 1. Similarly, claims 8-16 and 19 are patentable over the Bauer publication. Applicants respectfully request that the rejection of claims 1-19 over the Bauer publication be withdrawn.

5. Paragraph 10 of the Office Action Mailed March 14, 2006: Rejection of claims 20-30 Under 35 U.S.C. §103(a).

In the Office Action mailed March 14, 2006, the Examiner rejects claims 20-30 under 35 U.S.C. §103(a) as being unpatentable over the Bauer publication. Applicants respectfully traverse the rejection.

The Examiner believes claims 20-30 recite limitations already addressed by the rejection of claims 1-7. With respect to claims 20 and 21, the Examiner also believes the Bauer publication discloses the matrix of responses including preference results by input choices, but the Examiner acknowledges that the Bauer publication does not disclose the matrix and corresponding calculation results are generated by a computer and software executed thereon. The Examiner remarks that Official Notice is taken that it is old and well-known in the art of automation to utilize software executed by a computer to perform calculations and generate spreadsheets commonly completed by hand. The Examiner believes use of a computer to carry out these functions yields more accurate and rapid generation of calculation and spreadsheet results. The Examiner further believes that since the Bauer publication already teaches the recited matrix and calculations, that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of the Bauer publication to generate the recited matrix and calculations using software executed by a computer in order to yield more accurate and rapid generation of the calculation and spreadsheet results.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The Examiner bears the initial burden of establishing the *prima facie* case. See In re Piasecki, 223 U.S.P.Q. 785,787, 745 F.2d 1468, 1471 (Fed. Cir. 1984). Applicants respectfully submit that the Bauer publication does not teach or suggest all of the limitations of the invention as claimed and therefore, a *prima facie* case of obviousness has not been established.

As previously discussed herein and with respect to independent claim 20, the Bauer publication does not disclose calculating an upside and it does not disclose calculating a downside based on

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preference results. With respect to independent claim 21, the Bauer publication does not disclose a test results interpretation system including a computer code adapted to calculate product preference for a product by incorporating preference results and nonpreferential results. Therefore, the Bauer publication does not teach or suggest these aspects of the invention as claimed. Applicants respectfully request that the rejection be withdrawn.

In conclusion and for the reasons stated above, Applicants respectfully submit that presently presented claims 1-16 and 19-30 are patentable and in condition for allowance.

The Commissioner is hereby authorized to charge any prosecutorial fees (or credit any overpayment) associated with this communication to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such extension is requested and should also be charged to our Deposit Account.

The undersigned may be reached at: (920) 721-2433.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I, Mary L. Roberts, hereby certify that on July 6, 2006 this document is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300.

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